

### **REMARKS**

Claims 1-26 are currently pending in the application, with claims 1, 12, 18, 22, and 25 being independent. Claims 1, 4, 12, 14, 15, 18, 22, and 25 have been amended to more appropriately define the present invention. Claims 2, 3, 5-11, 13, 16, 17, 19, 20, and 24 have been amended to correct minor informalities. New claim 26 has been added. Applicants request favorable consideration in light of the amendments and remarks presented herein, and earnestly seek timely allowance of the pending claims.

### ***Examiner Interview***

Applicants wish to thank the Examiner for extending the courtesy of conducting a personal interview. During the interview, claims 1, 12, 22, 18, and 25 were discussed, and the Examiner agreed that including the term “tangible sheets” would overcome the rejections based upon Sklarew.

### ***Claim Rejections – 35 U.S.C. §102***

The Examiner rejected claims 1-3, 8, 10, 12-13 and 21 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,972,496 to Sklarew (“Sklarew”). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and respectfully traverse the rejection.

Sklarew merely discloses a handwritten keyboardless entry computer system. The system includes a transparent input screen that generates positional information when contacted by a stylus. The system includes a computer that is programmed to compile the position information into strokes, to calculate stroke characteristics, and then compare the stroke

characteristics with those stored in a database in order to recognize the symbol drawn by the stylus (Abstract). Specifically, Sklarew discloses storing a multiplicity of blank, fully or partly completed forms in the portable computer memory. In a hospital, “sheets” of patient data can be stored in the memory of the portable computer. The forms may also be downloaded into a central computer memory (col. 3, lines 35-45).

However, Sklarew fails to disclose, at least, “a plurality of tangible sheets associated with a position coding pattern,” as recited in claims 1 and 12 (emphasis added).

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 1 and 12. Claims 2-3, 8, 10 depend from claim 1 and are allowable at least for the reasons described above for allowable claim 1. Claim 13 depends from claim 12 and is allowable at least for the reasons described above for allowable claim 12.

The Examiner rejected claims 1-3, 7-8, 10-15, and 21-24 under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. No. 6,738,053 to Borgstrom (“Borgstrom”). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and respectfully traverse the rejection.

Borgstrom discloses predefined electronic pen functions and specially formatted paper. Using the detected pattern, a corresponding predefined function may be stored in a memory and can be identified and performed by a processor/controller (Abstract). Borgstrom further teaches an embodiment including an email form 280, and software in a server associated with the form that may recognize the form as an email form based on the underlying address pattern. The software may further recognize various fields of the email form 280. The page may be identified

by a page identification field 282, which may distinguish the page from other email forms 280. Several special function fields 284 may also be included. When the electronic pen 10 is used to touch or “click on” one of these fields 284, the corresponding function may be performed. For example, by writing a message and identifying an addressee or addressees in message field 286 and address fields 288, the server software may call a handwriting recognition application to convert the message into text and the address into a known email address. (See col. 7, line 58 – col. 8, line 5.)

However, Borgstrom fails to disclose, at least, “a second input field accepting descriptive information characterizing the digitally recorded information, wherein the descriptive information associates the filing appliance with an information object,” as recited in claims 1, 12, and 22.

Borgstrom is distinguished by the above quoted feature in that, for example, the page identification field 282 may distinguish the page from other email forms, and the address field 280 may correspond to an actual email address, but neither of these fields characterize the digitally recorded information and associate the filing appliance with an information object.

By providing a second input field that includes descriptive information that characterizes and associates the filing appliance with an information object, the capability is provided to re-access the information object associated with the filing appliance.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejections of claims 1, 12, and 22. Claims 2, 3, 7, 8, 10, 11, and 21 depend from claim 1 and are allowable at least for the reasons described above for allowable claim 1. Claims 13-15 depend from claim 12 and are allowable at least for the reasons described above for allowable claim 12. Claims 23 and

24 depend from claim 22 and are allowable at least for the reasons described above for allowable claim 22.

***Claim Rejections – 35 U.S.C. §103***

The Examiner rejected claims 18-20 and 25 under 35 U.S.C. §103(a) as being unpatentable over Sklarew and U.S. Pat. No. 6,563,494 to Eichstaedt et al. (“Eichstaedt”). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Sklarew merely teaches a handwritten keyboardless entry computer system. The system includes a transparent input screen that generates positional information when contacted by a stylus. A computer is programmed to compile the position information into strokes, to calculate stroke characteristics, and then compare the stroke characteristics with those stored in a database in order to recognize the symbol drawn by the stylus (Abstract). Sklarew further teaches storing a multiplicity of blank, fully or partly completed forms in the portable computer memory. The forms may also be downloaded into a central computer memory (col. 3, lines 35-45).

However, Sklarew fails to teach or suggest, at least, “a plurality of tangible sheets associated with first and second filing appliances,” as recited in claims 18 and 25 (emphasis added).

Eichstaedt fails to cure the deficiencies of Sklarew in this respect. Eichstaedt merely teaches a stylus which includes a wireless transceiver functionally coupling a computer, such as a first Personal Digital Assistant (PDA). Data residing in the first PDA can be transferred to the stylus, and subsequently the data can be wirelessly transferred to a second PDA. Thus, users of

PDA's may exchange data without manual entry or hardwired connections. (See Abstract.)

Accordingly, Applicants respectfully request the Examiner to withdraw the §103 rejection of claim 18 and 25. Claims 19-20 depend from claim 18 and are allowable at least by virtue of their dependence from allowable claim 18.

The Examiner rejected claims 18-20 and 25 under 35 U.S.C. §103(a) as being unpatentable over Borgstrom in view of Eichstaedt. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Borgstrom merely teaches predefined electronic pen functions and specially formatted paper. Using the detected pattern, a corresponding predefined function may be stored in a memory and can be identified and performed by a processor/controller (Abstract). Borgstrom further teaches an embodiment including an email form 280, and software in a server associated with the form that may recognize the form as an email form based on the underlying address pattern.

However, Borgstrom fails to teach or suggest, at least, "wherein the position information comprises activation information generated at the time point  $t_{act}$ , the activation information being indicative of an activation of the second filing appliance," as recited in claims 18 and 25 (emphasis added).

Eichstaedt fails to cure the deficiencies of Borgstrom in this respect. Eichstaedt merely teaches a stylus which includes a wireless transceiver functionally coupling a computer, such as a first Personal Digital Assistant (PDA). Data residing in the first PDA can be transferred to the stylus, and subsequently the data can be wirelessly transferred to a second PDA. Thus, users of

PDA's may exchange data without manual entry or hardwired connections. (See Abstract.)

Accordingly, Applicants respectfully request the Examiner to withdraw the §103 rejection of claim 18 and 25. Claims 19-20 depend from claim 18 and are allowable at least by virtue of their dependence from allowable claim 18.

The Examiner rejected claims 4-5 and 25 under 35 U.S.C. §103(a) as being unpatentable over Borgstrom in view of Gough. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claims 4-5 and depend from claim 1 and include all of the features recited therein. As provided above, Borgstrom fails to teach all of the features for claims 1 and 25.

Gough is silent with respect to "a second input field accepting descriptive information characterizing the digitally recorded information, wherein the descriptive information associates the filing appliance with an information object" as recited in claim 1 and "wherein the position information comprises activation information generated at the time point  $t_{act}$ , the activation information being indicative of an activation of the second filing appliance," as recited in claim 25, and therefore fails to cure the deficiencies of Borgstrom with respect to claims 1 and 25. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claims 4-5 and 25.

The Examiner rejected claims 4-5 under 35 U.S.C. §103(a) as being unpatentable over Sklarew in view of U.S. Pat. No. 5,603,053 to Gough et al. ("Gough"). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the

rejection.

Claims 4 and 5 depend from claim 1 and include all of the recitations of allowable claim

1. As provided above, Sklarew fails to teach all of the elements of claim 1.

Gough is silent with respect to “a plurality of tangible sheets associated with a position coding pattern,” and thus fails to cure the deficiencies of Sklarew in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 4 and 5.

The Examiner rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Sklarew and Gough in view of Microsoft PowerPoint (“PowerPoint”). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claim 6 depends from claim 1 and includes all of the recitations of claim 1. As provided above, Sklarew and Gough fail to teach all of the elements of claim 1.

PowerPoint is silent with respect to “a plurality of tangible sheets associated with a position coding pattern,” and thus fails to cure the deficiencies of Sklarew and Gough in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 6.

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Sklarew in view of U.S. Pat. No. 5,950,188 to Wildermuth (“Wildermuth”). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claim 9 depends from claim 1 and includes all of the recitations of claim 1. As provided above, Sklarew fails to teach all of the elements of claim 1.

Wildermuth is silent with respect to “a plurality of tangible sheets associated with a position coding pattern,” and thus fails to cure the deficiencies of Sklarew in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 9.

The Examiner rejected claims 11, 14-15, and 17 under 35 U.S.C. §103(a) as being unpatentable over Sklarew in view of U.S. Pat. No. 5,535,063 to Lamming (“Lamming”). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claim 11 depends from claim 1 and includes all of the recitations of allowable claim 1, claims 14-15 and 17 depend from claim 12 and include all of the recitations of allowable claim 12. As provided above, Sklarew fails to teach all of the elements of claims 1 and 12.

Lamming is silent with respect to “a plurality of tangible sheets associated with a position coding pattern,” and thus fails to cure the deficiencies of Sklarew in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 11, 14-15, and 17.

The Examiner rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Borgstrom and Gough in view of PowerPoint. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claim 6 depends from claim 1 and includes all of the recitations of allowable claim 1. As



provided above, Borgstrom and Gough fail to teach all of the elements of claim 1. PowerPoint fails to cure the deficiencies of Borgstrom and Gough in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 6.

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Borgstrom in view of Wildermuth. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claim 9 depends from claim 1 and includes all of the recitations of allowable claim 1. As provided above, Borgstrom fails to teach all of the elements of claim 1. Wildermuth fails to cure the deficiencies of Borgstrom in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 9.

The Examiner rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Borgstrom in view of U.S. Pat. No. 6,335,727 to Morishita et al. ("Morishita"). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claim 16 depends from claim 12 and includes all of the recitations of allowable claim 12. As provided above, Borgstrom fails to teach all of the elements of claim 12. Morishita fails to cure the deficiencies of Borgstrom in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 16.

The Examiner rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over

Borgstrom in view of Lamming. Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverse the rejection.

Claim 17 depends from claim 12 and includes all of the recitations of allowable claim 12. As provided above, Borgstrom fails to teach all of the elements of claim 12. Lamming fails to cure the deficiencies of Borgstrom in this respect. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 17.

New claim 26 recites the capability provided by the recitation expressed, *inter alia*, in claim 1.

### ***Conclusion***

In view of the above amendments and remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at telephone number (703) 205-8000, which is located in the Washington, DC area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

**Date: March 3, 2006**

Respectfully submitted,

By 

Michael K. Matter, Registration No.: 29,680  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road, Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant